

REMARKS

As noted by the Examiner, the Examiner initiated telephone interviews with Mr. Michael Whitham on June 4, 2003. The purpose of those interviews was, according to the understanding of Mr. Michael Whitham, to discuss possible amendments to the claims in order to obtain allowance of the case. The Examiner, in support of his position that amendments were necessary, cited U.S. Patent No. 5,768,384 to Berson and U.S. Patent No. 5,673,318 to Bellare et al. Also as noted by the Examiner, copies of these newly cited references were supplied by Mr. Michael Whitham to the inventors for their review and comment. The undersigned had conversations with the inventors and, based on those conversations, developed proposed amendments to claims 1, 16 and 21 in an effort to respond to the Examiner. On June 26, 2003, Mr. Michael Whitham had a further telephone interview with the Examiner and discussed the proposed amendments to claims 1, 16 and 21. Mr. Michael Whitham followed up this telephone interview by sending the Examiner an e-mail with drafts of the proposed amendments and comments on the Berson and Bellare et al. patents. At no time during the telephone interview did the Examiner mention that he had already issued a final rejection in the case which had been mailed on June 18, 2003. Since both Mr. Michael Whitham and the undersigned were making every effort to timely respond to the Examiner's originally initiated telephone interview and the Examiner was fully aware that the comments of the inventors were being solicited, it is submitted that the final rejection was premature, necessitating the filing of this Request for Continued Examination.

The undersigned notes the lengthy prosecution in this application, comprising now six Office Actions, a corresponding number of amendments, and an Appeal to the Board of Patent Appeals and Interferences, in response to which the Examiner withdrew an earlier final rejection. This application has been pending now for almost five years and is based on a parent application that was issued more than two years ago. The Examiner's premature final rejection which

has necessitated this Request for Continued Examination has exasorbed this protracted prosecution.

Turning now to the most recent Office Action, before treating the claims substantively, the Examiner cites, in addition to the Berson and Bellare et al. patents, U.S. Patent No. 4,785,290 to Goldman. The Examiner discusses each of these three patents and U.S. Patent No. 4,758,714 to Carlson et al., previously cited and relied upon in other Office Actions. The following comments are in response to the citations of these references

The patent to Bellare et al. is entirely irrelevant to the disclosed and claimed invention. This patent is directed to a method and apparatus for data authentication in a data communication environment. the only thing it has in common with the disclosed and claimed invention is the word "authentication". Bellare et al. has nothing to do with authentication of manufactured products for the purpose of preventing counterfeiting.

Berson on the other hand is concerned with a system for identifying, authenticating and tracking articles of manufacture throughout their manufacturing and distribution channels. According to the Berson patent, and as illustrated in Figure 3, manufacturing meters 25 are located at authorized manufacturing locations and produce encrypted data that is uniquely associated with each manufactured article. The inputs to the manufacturing meter are a manufacturing information device 39 and a data center 40. A bar code generator 45 encodes the information from encryptor 43. A printer 54 located at the authorized manufacturing locations prints the information encrypted by encryptor 43 of the meter 25 on a product label or tag 55. In order to ascertain if the article manufactured that has the tag 55 affixed to it is genuine, the bar code on the tag 55 is scanned by scanner 56. The encrypted information contained in the bar code printed on tag 55 is retrieved and then compared against information retrieved from the scan of associated documents. For instance, scanner 56 may scan information contained in invoice 26 (Figure 2). If the scanned information on tag 55 matches or is correctly related to the scanned information on the invoice 26, the

manufactured article is in the correct distribution channel and the article is genuine. See the paragraph bridging columns 4 and 5 of the patent.

In contrast to the Berson patent, the claimed invention is directed to a self-contained authentication system and method. That is, unlike Berson, reading the electronic tag of the claimed invention does not require comparing the decrypted information derived from the electronic tag against information retrieved from the sanc of associated documents. In other words, the tag is self-authenticating. This is possible because of the nature of the electronic tag with memory as contrasted with the printed bar code as used in the Berson system. It is noted that the present application does contemplate the possibility of a visible label in addition to the electronic tag. The visible label may contain a serial number and be printed as a bar code. The customer and/or the sales clerk could compare the printed serial number with a serial number decripted from the electronic tag; however, this is an enhancement on the basic idea of storing all the information needed for self-authentication in the electronic tag. In other words, by the customer and/or the sales clerk comparing the serial number on the visible label with a serial number generated from the information stored in the electronic tag, the customer and/or the sales clerk can be provided with an extra level of assurance of the authenticity of the product.

The patent to Goldman was not identified by the Examiner in his telephone interview with Mr. Michael Whitham on June 6, 2003. Goldman discloses a non-counterfeitable document system which uses tags that have a measurable characteristic that involves light transmissivity and reflectivity. This characteristic is sensed using spectrographic apparatus to provide signals indicative of the varying translucency. A reference numeral is then provided from some registered form, and this numeral may be cryptographically encoded. For verification, the light transmissivity and reflectivity characteristic of the tag is sensed to produce signals which are then compared with signals that were previously sensed as the characteristic of the tag. In addition to the transmissivity and reflectivity characteristic, images and a magnetic medium may also be provided. The

magnetic medium may be used for information on shelf life and sales channels.

From the foregoing, it is clear that while Goldman, like Berson, is concerned with preventing counterfeiting of manufactured goods, among other things, Goldman has an entirely different approach to the problem than that of the disclosed and claimed invention. In Goldman, the light transmissivity and reflectivity of a portion of the tag is unique to the tag but bears no information concerning the product to which it is attached.

The Examiner additionally mentions "Carlson's patent" but fails to identify the patent by patent number. It is believed that the Examiner has reference to U.S. Patent No. 4,758,714 to Carlson et al., previously of record. Since this patent is relied on by the Examiner in various rejections of the claims, comments on this patent are reserved for the responses to those rejections.

The Examiner also provides a discussion concerning his interpretation of cited case law concerning the recitation of "an intended use" for a system claim. The Examiner's interpretation, without specific application in a rejection of a claim or claims, appears to be both in error and irrelevant. Suffice it to say that the claims are not couched, as the Examiner seems to suppose, in terms of an old device intended to be used in new way. The recited system and method are entirely new, but based on known technologies, as are many inventions.

The Examiner then makes reference to several articles, but it is not clear that these are being relied upon by the Examiner in any specific way in the substantive examination of this patent application. In any case, copies of the articles were not attached, as stated by the Examiner, and were not listed in the Notice of References Cited, PTO-892, attached to the Office Action. Applicants therefore cannot respond to the Examiner's comments concerning these articles. If the Examiner intends to rely on any of these articles, he is requested to formally cite them and provide copies.

Next, the Examiner makes reference to the Fuji-Keizai USA, Inc. article, originally cited in the second Office Action mailed August 30, 2000, but it is only later in the rejections of the claims that the Examiner relies on the article in his

substantive examination of this patent application. Comments on this article are reserved for the responses to the rejections of the claims.

Claims 1 to 13 and 15 to 23 now appear in the application. By this amendment, claims 1, 11, 16, and 21 are amended, and new claims 22 and 23 are added. The amendment to claim 11 is to correct a punctuation error, that is, the comma between “product routing” and “information” is to be deleted.

Claims 1, 5, 6, 8 to 10, and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over the article of Fuji-Keizai USA, Inc. in view of U.S. Patent No. 4,758,714 to Carlson et al. Apparently, the Examiner had intended to include claim 18 in this rejection since it is specifically mentioned on page 9 of the Office Action. This rejection is again respectfully traversed for the reason that the combination of Fuji-Keizai USA, Inc. article and the Carlson et al. patent fail to teach the claimed invention.

The claimed invention is a system and method for verifying authenticity of a manufactured product to protect against counterfeiting. In the practice of the claimed invention as set forth in claim 1, an electronic tag is attached to one of the product and product packaging. This electronic tag comprises a memory for storing authentication information for the product. A reader reads the authentication information from the electronic tag to verify that the product is authentic. This is shown in Figure 3 where the electronic tag is in the form of a smart card 211 and is read by a reader 215. What the invention does is to authenticate the product; it does not authenticate the card, a payment or the identity of a customer. And claim 1 is quite clear on that point. Claim 1 has been amended to recite that the authentication is “based *solely* on the information contained in said electronic tag” (emphasis added), that is, it is self-authenticating.

Claim 5 is dependent on claim 1 and adds a point of sale machine containing the reader for authenticating said product in front of a consumer prior to purchase of the product. Claim 6 is also dependent on claim 1 and adds that the reader comprises means for reading the electronic tag without physically contacting said electronic tag. Claim 8 is also dependent on claim 1 and adds that

the authentication information is directed to a manufacturer of the product. Claim 9, also dependent on claim 1, adds that the authentication information is specific to the product. Claim 10, also dependent on claim 1, adds a label having the authentication information printed thereon to be verified against the authentication information read by the reader. Claim 15, also dependent on claim 1, recites that the authentication information additionally comprises information for authenticating the electronic tag. Claim 18 is a method claim which is dependent on claim 16 and, similar to claim 10, recites the step of "attaching a printed label to said product comprising said authentication information."

The primary reference relied on by the Examiner, identified as the Fuji-Keisai USA, Inc. article and entitled "Major Trends in Europe's Top 40 High-Tech Companies 1997", is a very brief survey of products currently manufactured and future plans of Gemplus of France. These products include "smart PVC cards, ABS smart cards, contactless cards, electronic tags, chip design, development of operating systems and application software, card printing and assembly, extended personalization services, card reader design and manufacturing, and interface design". New products include "an RF/ID product range." Under the topic of "Future plans", the article mentions "a smart card reader in PC Card format with a cryptographic engine" and new cards to "handle a wide range of functions for various applications such as computer security, information highways, healthcare, banking, and telecommunications and instantly encrypt and decrypt data." The article states that "It is expected that by the year 2010, most transactions will take place over electronic networks" and that "Smart cards are one of the ways that security can be offered on such information superhighways." The various applications for the Gemplus smart cards include "Internet commerce, pay-TV subscription, university cards, wireless telecommunications, laundromats, automatic fare collection booths, and banking."

It will be observed that nothing in the Fuji-Keisai USA, Inc. article mentions or suggests protecting against counterfeiting. Virtually all the applications mentioned are concerned with commercial transactions and, by

implication, the secure exchange of money. While it could well be that the type of electronic tag contemplated by the claimed invention could be manufactured by Gemplus, the fact is that Gemplus has not, at least according to the Fuji-Keizai USA, Inc. article, made such electronic tags nor has Gemplus contemplated the application of such electronic tags to preventing counterfeiting. To put it in more concrete terms of a specific example, suppose that Levi Strauss, the manufacturer of Levis® brand jeans, wants to prevent the sale of counterfeit jeans. The claimed invention allows the manufacturer to embed an electronic tag in the jeans, say behind the leather patch, an electronic tag which can be used to authenticate the jeans as authentic Levis® brand jeans.

The Examiner's interpretation of case law related to "intended use" seems to be an attempt by the Examiner to ignore specifically recited limitations in the claims and thereby characterize the claimed invention as simply a smart card. Otherwise, the Examiner's continued reliance on the Fuji-Keizai USA, Inc. article makes no sense because it is quite devoid of any teaching of the subject matter of the claimed invention. Claim 1 recites "*A system for verifying authenticity of a manufactured product*". MPEP 2111.02 states that "[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). Further, "If the claim preamble, when read in the context of the entire claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-1166 (Fed. Cir. 1999). The system recited in claim 1 comprises, first, "an electronic tag attached to one of said product and product packaging, said electronic tag comprising a *memory storing authentication information for said product*" and, second, "a reader for reading said authentication information from said electronic tag to verify that said product is authentic based solely on the information contained in said memory without revealing said authentication information". Thus, the body of the claim clearly

refers back to the preamble of the claim giving "life, meaning, and vitality" to the claim. The Fuji-Keizai USA, Inc. article has no hint of such a system.

The patent to Carlson et al. is directed to a point-of-sale (POS) mechanism which is used in transactions involving credit cards, negotiable instruments and the like. This device is in no way usable or intended to be used to authenticate a product to prevent counterfeiting. The Examiner indicates that Carlson et al. is cited for the use of public/private keys. While the disclosed preferred embodiment of the invention uses public/private key encryption techniques, such techniques are not necessary to the practice of the invention and, therefore, claim 1 has been amended to delete any reference to encryption and decryption.

It is clear from the foregoing that the combination of the Fuji-Keizai USA, Inc. article and the patent to Carlson et al. do not suggest or otherwise make obvious under the standards of 35 U.S.C. §103(a) the claimed invention. The Examiner is again reminded of the standard for a rejection under Section 103 as set out in MPEP 2141, which standard is an objective standard that proscribes the use of hindsight. The rejection is therefore clearly in error and withdrawal of the rejection is respectfully requested.

Although not formally stated, it is understood that claim 2 was rejected under 35 U.S.C. §103 as being unpatentable over the Fuji-Keizai USA, Inc. article in view of the patent to Carlson et al. further in view of U.S. Patent No. 5,901,303 to Chew. This rejection is also respectfully traversed for the reason that claim 2, which is dependent on claim 1, is not taught by the combination of the Fuji-Keizai USA, Inc. article and the patents to Carlson et al. and Chew.

The combination of the Fuji-Keizai USA, Inc. article and Carlson et al. is distinguished as in the response to the rejection of claim 1, above. Whereas the Fuji-Keizai USA, Inc. article briefly describes the Gemplus smart card, the patent to Chew (assigned to Gemplus) discloses in detail the structure of the Gemplus smart card. It does not, however, suggest how the Gemplus smart card might be used to authenticate a manufactured product to protect against counterfeiting. Therefore, Chew is, at best, cumulative in its teaching and adds nothing which

would make up for the deficiencies already noted with respect to the Fuji-Keizai USA, Inc. article and the patent to Carlson et al.

Although not formally stated, it is understood that claim 3 was rejected under 35 U.S.C. §103 as being unpatentable over the Fuji-Keizai USA, Inc. article in view of the patent to Carlson et al. further in view of U.S. Patent No. 5,367,148 to Storch et al. This rejection is also respectfully traversed for the reason that the combination of the Fuji-Keizai USA, Inc. article and the patents to Carlson et al. and Storch et al. neither show nor suggest the claimed invention.

Claim 3 is dependent on claim 1 and adds that the electronic tag is embedded into one of the product and product packaging product. The combination of the Fuji-Keizai USA, Inc. article and the Carlson et al. patent are distinguished as in the response to the rejection of claim 1, above. The patent to Storch et al. is directed to counterfeit detection, but the approach by Storch et al. is the use of random ID numbers on a product return card and a product package. The Storch et al. patent is specifically acknowledged on page 3, line 17, of this patent application. Problems with this approach are outlined bridging pages 3 and 4 of this patent application. The electronic tag used in the claimed invention is a completely different approach than that taken by Storch et al. and involves none of the problems associated with the Storch et al. approach. It is therefore clear that the rejection of claim 3 based on the combination of the Fuji-Keizai USA, Inc. article and the patents to Carlson et al. and Storch et al. is in error, and withdrawal of the rejection is respectfully requested.

Claim 4 was rejected under 35 U.S.C. §103 as being unpatentable over the article of Fuji-Keizai USA, Inc. in view of U.S. Patent No. 5,740,250 to Moh further in view of the patent to Carlson et al. This rejection is respectfully traversed for the reason that the combination of the Fuji-Keizai USA, Inc. article and the patents to Moh and Carlson et al. fail to show or suggest the claimed invention.

Claim 4 is dependent on claim 1 and adds that the authentication information is encrypted using a private key and that the reader decrypts the

information using a corresponding public key. The combination of the Fuji-Keizai USA, Inc. article and the Carlson et al. patent are distinguished as in the response to the rejection of claim 1, above. The patent to Moh is directed to a tame automorphism based encryption system using public/private keys for secure data transmission. Moh is not concerned with protecting manufactured goods from counterfeiting.

It is therefore clear that the rejection of claim 3 based on the combination of the Fuji-Keizai article and the patents to Moh and Carlson et al. is in error, and withdrawal of the rejection is respectfully requested.

Claim 7 was rejected under 35 U.S.C. §103 as being unpatentable over the article by Fuji-Keizai USA, Inc. in view of U.S. Patent No. 5,140,634 to Guillou et al. It is not clear, however, whether the Examiner also relies on the patent to Carlson et al. for this rejection since he did so in rejecting independent claim 6 on which claim 7 is dependent. In any case, this rejection is respectfully traversed for the reason that the combination of the Fuji-Keizai USA, Inc. article and the patent(s) to Guillou et al. (and Carlson et al.) fail to show or suggest the claimed invention.

Claim 7 is dependent on claim 1 and recites that a zero-knowledge protocol is used to make authentication information resistant to duplication. The patent to Guillou et al. is related to a method and system for authenticating messages with zero-knowledge proof and signing of messages. Guillou et al. have nothing to do with protecting manufactured goods from counterfeiting.

Since neither the Fuji-Keizai article nor the patent to Guillou et al. patent have any thing to do with protecting manufactured goods from counterfeiting, it is clear that the rejection of claim 7 based on the combination of the Fuji-Keizai USA, Inc. article and the patent(s) to Guillou et al. (and Carlson et al.) is in error, and withdrawal of the rejection is respectfully requested.

The Examiner treats claim 17 as similar to claim 7. Claim 17 is a method claim dependent on claim 16 and recites the step of using a zero-knowledge protocol to make authentication information resistant to duplication. The rejection

of claim 17 is in error for the same reasons advanced with respect to claim 7, and the rejection of claim 17 should be withdrawn for the same reasons.

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over the Fuji-Keizai USA, Inc. article in view of the Storch patent. It is not clear, however, whether the Examiner also relies on the patent to Carlson et al. for this rejection since he did so in rejecting dependent claim 9 on which claim 11 is dependent. This rejection is respectfully traversed for the reason that the combination of the Fuji-Keizai USA, Inc. article and the patent(s) to Storch et al. (and Carlson et al.) fail to suggest the claimed invention.

Claim 11 recites that the “authentication information comprises one or more of product color, product shape, product serial number, product weight product routing information, and product chemical composition.” As demonstrated above, the Fuji-Keizai USA, Inc. article has nothing to do with preventing counterfeiting of manufactured products, and the electronic tag used in the claimed invention is a completely different approach than that taken by Storch et al. and involves none of the problems associated with the Storch et al. approach. It is therefore clear that the rejection of claim 11 based on the combination of the Fuji-Keizai USA, Inc. article and the patent(s) to Storch et al. (and Carlson et al.) is in error, and withdrawal of the rejection is respectfully requested.

Claim 12 was rejected under 35 U.S.C. §103 as being unpatentable over the Fuji-Keizai USA, Inc. article. It is not clear, however, whether the Examiner also relies on the patent to Carlson et al. for this rejection since he did so in rejecting dependent claim 9 on which claim 12 is dependent. This rejection is respectfully traversed for the reason that the Fuji-Keizai USA, Inc. article is not relevant to the a system for preventing counterfeiting of manufactured products.

Claim 12 add the limitation that the “authentication information comprises a *graphic image of the product*” (emphasis added). The rejection of claim 12 as unpatentable over the Fuji-Keizai USA, Inc. article is clearly in error, and withdrawal of the rejection is respectfully requested.

Claims 13 and 20 were rejected under 35 U.S.C. §103 as being

unpatentable over the Fuji-Keizai USA, Inc. article in view of U.S. Patent No. 5,971,435 to DiCesare et al., and further in view of the patent to Carlson et al. This rejection is also respectfully traversed for the reason that the combination of the Fuji-Keizai USA, Inc. article and the patents to DiCesare et al. and Carlson et al. do not suggest the claimed invention.

Claim 13 is also dependent on claim 9 and adds that the “authentication information comprises *an ownership history of the product*” (emphasis added). Claim 20 is a method claim which is dependent on claim 16 and similarly recites the step of “recording *an ownership history of said product in said electronic tag*” (emphasis added). The combination of the Fuji-Keizai USA, Inc. article and the patent to Carlson et al. has already been distinguished from the claimed invention above. The patent to DiCesare et al. is directed to a method and system for verifying the authenticity and ownership of an autograph, such as an autographed item of memorabilia. The process is shown in Figure 1 of DiCesare et al. and involves a celebrity autographing an item in the presence of a consumer and authentication company representative, signing by the consumer and representative a numbered voucher bearing a description of the autographing event, affixing the code number to the item, retaining in a database maintained by the authenticating company the voucher and the information contained thereon, and providing the consumer with a certificate of authenticity by the authentication company. This is the type of authenticating system described on pages 3 and 4 of the present application, one of the problems of which is the requirement of the authentication company maintaining a database. In any case, there is nothing in DeCesare et al. that would suggest the use of an electronic tag as used in the practice of the claimed invention.

From the foregoing, it is clear that the rejection of claims 13 and 20 based on the combination of the Fuji-Keizai USA, Inc. article and the patents to DiCesare et al. and Carlson et al. is in error, and withdrawal of the rejection is respectfully requested.

Claim 19 was rejected under 35 U.S.C. §103 as being unpatentable over

the Fuji-Keizai USA, Inc. article in view of U.S. Patent No. 5,164,988 to Matyas et al. This rejection is respectfully traversed for the reason that the combination of the Fuji-Keizai USA, Inc. article and the patent to Matyas et al. fails to suggest the claimed invention.

Claim 19 is a method claim which is dependent on claim 16 and recites the step of erasing the authentication information from said electronic tag after reading. The patent to Matyas et al. is directed to a method to establish and enforce a network cryptographic security policy in a public key cryptosystem. The Matyas et al. method involves making a certified public key unavailable in the event that there is an attempt to change a configuration vector of a device. Matyas et al. has nothing whatsoever to do with protecting manufactured goods from counterfeiting nor does Matyas et al. have anything to do with smart cards as described in the Fuji-Keizai USA, Inc. article.

It is clear that the rejection of claim 19 based on the combination of the Fuji-Keizai USA, Inc. article and the patent to Matyas et al. is in error, and withdrawal of the rejection is respectfully requested.

Claims 16 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable, but without a definite citation to prior art. Instead, the Examiner refers to claims 1 to 15 (but note that claim 14 has been canceled); however, claims 1 to 13 and 15 have been rejected on various combinations of the prior art, so the specific grounds of rejection of claims 16 and 21 are unclear. Nevertheless, the rejection is respectfully traversed for the reason that the Examiner has failed to cite any prior art that would in fact make obvious the invention as recited in claims 16 and 21.

Claims 16 and 21 are independent method claims which, like claim 1, have been amended to recite that the verifying step is performed "based solely on the information in said electronic tag". In the case of claim 16, this step is performed "without revealing said authentication information". The combinations of steps recited in claims 16 and 21, respectively, are nowhere suggested by the prior art of record, and the Examiner's attempt to cobble together references to meet the

specific limitations recited in claim 16 can only be characterized as impermissible hindsight. Claim 21, treated separately below, is also clearly patentable over the prior art of record. Therefore, a rejection of claims 16 and 21 over any combination of references of record would be clearly in error, and withdrawal of any such rejection is respectfully requested.

Claim 21 is separately rejected in paragraph 27 on page 20 under 35 U.S.C. §103(a) as being unpatentable over the Fuji-Keizai USA, Inc. article and the patent to Matyas et al. and Carlson et al., further in view of a Dialog Classic article "of GE Capital and GEMPLUS . . ." This rejection is also respectfully traversed for the reason that the combination of the Fuji-Keizai USA, Inc. article, the patents to Matyas et al. and Carlson et al., and the Dialog Classic article fail to show or suggest the claimed invention.

Claim 21 is directed to a method for detecting manufactured products in a parallel market, i.e., so-called "grey market", as illustrated in Figure 4 of the drawings in this patent application. None of the references relied on by the Examiner to reject claim 21 have anything to do with protecting manufactured goods from counterfeiting, in general, and certainly nothing to do with protecting manufactured goods in a grey market situation. It is clear that the rejection of claim 21 based on the combination of the Fuji-Keizai USA, Inc. article, the patents to Matyas et al. and Carlson et al., and the Dialog Classic article is in error, and withdrawal of the rejection is respectfully requested.

Similar to claim 1, claims 16 and 21 have been amended to delete reference to the steps of encrypting and decrypting the authentication information. New claims 22 and 23, respectively dependent on claims 16 and 21, have been added to recite those steps.

The Examiner is reminded of the basic considerations which apply to obviousness rejections as set out in MPEP 2141. Specifically, "When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

"(A) The claimed invention must be considered as a whole;

"(B) The references must be considered as a whole and must suggest the

desirability and thus the obviousness of making the combination;
“(C) The references must be viewed without the benefit of impermissible
hindsight vision afforded by the claimed invention; and
“(D) Reasonable expectation of success is the standard with which
obviousness is determined.”

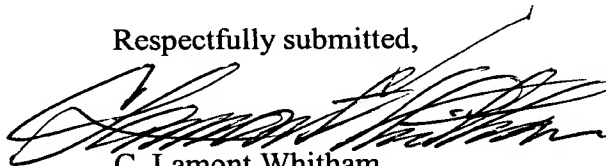
It is submitted that throughout the lengthy prosecution of this patent application, the Examiner has failed to follow the instructions set out in MPEP 2141 and has, instead, engaged in speculation, misinterpretation and impermissible reconstruction of the references relied upon. The standard of 35 U.S.C. §103(a) is an objective standard, as set out above, and it is the Examiner's duty to apply that objective standard, not to engage in subjective speculation as is evident in his “Response” and “Conclusion”. The fact is that the Examiner has failed to find any prior art which protects manufactured goods against counterfeiting in the manner according to the claimed invention. For that reason, it is respectfully requested that the application be reconsidered, that claims 1 to 13 and 15 to 21 be allowed, and that the application be passed to issue.

In view of the foregoing, it is respectfully requested that the application be reconsidered, that claims 1 to 13 and 15 to 23 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

A provisional petition is hereby made for any extension of time necessary for the continued pendency during the life of this application. Please charge any fees for such provisional petition and any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. Lamont Whitham', is written over the typed name.

C. Lamont Whitham

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